

REMARKS

Claims 1-21 are pending. Claims 5, 12 and 19 are rejected under 35 U.S.C. §112, second paragraph. Claims 1-4, 7-11, 14-18 and 21 are rejected under 35 U.S.C. §102(b). Claims 5-6, 12-13 and 19-20 are rejected under 35 U.S.C. §103(a). Applicants address these rejections below.

Applicants thank Examiner Rendon for discussing the rejections with Applicants' Attorney, Bobby Voigt, on October 29, 2007.

I. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH:

The Examiner has rejected claims 5, 12 and 19 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Office Action (8/6/2007), page 2. In particular, the Examiner asserts that the phrase "subset of members of the second set of physical entities defines a set of a set of experimental protocols" in claims 5, 12 and 19 is unclear. *Id.* As indicated above, Applicants amended claims 5, 12 and 19 to remove the second repetition of "a set of" to thereby clarify the claimed subject matter. The Examiner agreed that by removing the second repetition of "a set of" in claims 5, 12 and 19 that claims 5, 12 and 19 are now allowable under 35 U.S.C. §112, second paragraph. Applicants respectfully request the Examiner to withdraw the rejections of claims 5, 12 and 19 under 35 U.S.C. §112, second paragraph.

As stated above, claims 5, 12 and 19 were amended to clarify the claimed subject matter and not to overcome prior art. Hence, no prosecution history estoppel arises from the amendments to claims 5, 12 and 19. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 5, 12 and 19 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

## II. REJECTIONS UNDER 35 U.S.C. §102(b):

The Examiner has rejected claims 1-4, 7-11, 14-18 and 21 under 35 U.S.C. §102(b) as being anticipated by "The Beginner's Guide to Ultima Online v2.2" (hereinafter "Drye"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

Applicants respectfully assert that Drye does not disclose "identifying a subset of members of the second set of physical entities corresponding to members of the second set of entities in the massively multiplayer online game having an outcome exceeding a preselected outcome" as recited in claim 1 and similarly in claims 8 and 15. As understood by Applicants, the Examiner cites page 16, paragraph 5 as well as page 9 of Drye as disclosing the above-cited claim limitation. Office Action (8/6/2007), page 3. Applicants respectfully traverse.

Drye instead discloses that a common mistake when attacking several monsters of the same type is to double-click a creature, lose track of which one is which, then stand there like a moron when the other one is hurting you. Page 16, paragraph 5. Drye further discloses that even if the first one is far away, your character will continue to focus on it and will not attack another monster that is up close and hurting him. Page 16, paragraph 5. Drye additionally discloses if you have been killed by another player, you will be given an opportunity to report the murder. Page 9. Further, Drye discloses that players cannot be attacked just because they are evil; however, they can be attacked if they have committed a crime that someone saw within the previous two minutes. Page 9.

Hence, Drye discloses that a common mistake when attacking several monsters of the same type is to lose track of which one is which. Further, Drye discloses that if you have been killed by another player, you will be given an opportunity to report the murder. Further, Drye discloses that players cannot be

attacked just because they are evil; however, they can be attacked if they have committed a crime that someone saw within the previous two minutes.

There is no language in the cited passages that discloses identifying a subset of members of the second set of physical entities. As recited in claims 1, 8 and 15, the second set of physical entities is mapped to the second set of entities in the massively multiplayer online game. Applicants respectfully request the Examiner to particularly point out in Drye where Drye allegedly discloses the second set of physical entities as well as the second set of entities pursuant to 37 C.F.R. §1.104(c)(2). Neither is there any language in the cited passages that discloses identifying a subset of members of the second set of physical entities corresponding to members of the second set of entities in the massively multiplayer online game having an outcome exceeding a preselected outcome. Thus, Drye does not disclose all of the limitations of claims 1, 8 and 15, and thus Drye does not anticipate claims 1, 8 and 15. M.P.E.P. §2131.

Applicants further assert that Drye does not disclose "sending results of the quest and the identified subset of members of the second set of physical entities to a remote data processing system for analysis" as recited in claim 1 and similarly in claims 8 and 15. As understood by Applicants, the Examiner cites page 16, paragraph 5 as well as page 9 of Drye as disclosing the above-cited claim limitation. Office Action (8/6/2007), page 3. Applicants respectfully traverse.

As discussed above, Drye instead discloses that a common mistake when attacking several monsters of the same type is to lose track of which one is which. Further, Drye discloses that if you have been killed by another player, you will be given an opportunity to report the murder. Further, Drye discloses that players cannot be attacked just because they are evil; however, they can be attacked if they have committed a crime that someone saw within the previous two minutes.

There is no language in the cited passages that discloses sending results of the quest and the identified subset of members of the second set of physical entities to a remote data processing system for analysis. Thus, Drye does not disclose all of the

limitations of claims 1, 8 and 15, and thus Drye does not anticipate claims 1, 8 and 15. M.P.E.P. §2131.

Claims 2-4, 7, 9-11, 14, 16-18 and 21 each recite combinations of features of independent claims 1, 8, and 15, respectively, and hence claims 2-4, 7, 9-11, 14, 16-18 and 21 are not anticipated by Drye for at least the above-stated reasons that claims 1, 8 and 15 are not anticipated by Drye.

Claims 2-4, 7, 9-11, 14, 16-18 and 21 recite additional features, which, in combination with the features of the claims upon which they depend, are not anticipated by Drye.

For example, Drye does not disclose "logging each interaction of the members of the first and second sets in response to player manipulations and corresponding outcomes of said quest of each of the interactions" as recited in claim 2 and similarly in claims 9 and 16. As understood by Applicants, the Examiner cites page 16, paragraph 5 as well as page 9 of Drye as disclosing the above-cited claim limitation. Office Action (8/6/2007), page 3. Applicants respectfully traverse.

As discussed above, Drye instead discloses that a common mistake when attacking several monsters of the same type is to lose track of which one is which. Further, Drye discloses that if you have been killed by another player, you will be given an opportunity to report the murder. Further, Drye discloses that players cannot be attacked just because they are evil; however, they can be attacked if they have committed a crime that someone saw within the previous two minutes.

There is no language in the cited passages that discloses logging each interaction of the members of the first and second sets. Neither is there any language in the cited passages that discloses logging each interaction of the members of the first and second sets in response to player manipulations. Neither is there any language in the cited passages that discloses logging each interaction of the members of the first and second sets in response to player manipulations and corresponding outcomes of the quest of each of the interactions. Thus, Drye does not disclose all of the limitations of claims 2, 9 and 16, and thus Drye does not anticipate claims 2, 9 and 16. M.P.E.P. §2131.

Applicants further assert that Drye does not disclose "wherein said subset of members of the second set of physical entities comprises a sequence of second entities selected from an output of said logging step, and wherein a physical model problem solution comprises said sequence of second entities" as recited in claim 3 and similarly in claims 10 and 17. As understood by Applicants, the Examiner cites pages 4, 22 and 27 of Drye as disclosing the above-cited claim limitations. Office Action (8/6/2007), pages 3-4. Applicants respectfully traverse.

Drye instead discloses that you can log off anywhere, but your character is generally a sitting duck if he is attacked. Page 4. Drye further discloses that in order to avoid this, find an inn, walk into one of the rooms, and then log off. Page 4. Drye further discloses that pets do not tend to stick around after logging off because you have to feed them right before you log off or else they'll go wild very quickly. Page 22. Drye additionally discloses that boats can disappear after a while if you just leave them lying around and then log off. Page 27. Drye further discloses that to prevent this you have to be at anchor, and have PCs of some sort walk by it every now and then. Page 27.

Hence, Drye discloses that when you log off, if you want to protect your character, you should find an inn and walk into one of the rooms prior to logging off. Also, Drye discloses that pets and boats can disappear after logging off unless precautions are used (e.g., have the boat be at anchor and have PCs of some sort walk by it every now and then).

There is no language in the cited passages that discloses that the subset of members of the second set of physical entities comprises a sequence of second entities selected from an output of the logging step. Further, there is no language in the cited passages that discloses that a physical model problem solution comprises the sequence of second entities. Thus, Drye does not disclose all of the limitations of claims 3, 10 and 17, and thus Drye does not anticipate claims 3, 10 and 17. M.P.E.P. §2131.

Applicants further assert that Drye does not disclose "wherein a set of transitions between members of said sequence of said second entities comprises an

algorithm for said physical model problem solution" as recited in claim 4 and similarly in claims 11 and 18. As understood by Applicants, the Examiner cites pages 4, 22 and 27 of Drye as disclosing the above-cited claim limitations. Office Action (8/6/2007), pages 3-4. Applicants respectfully traverse.

As discussed above, Drye instead discloses that when you log off, if you want to protect your character, you should find an inn and walk into one of the rooms prior to logging off. Also, Drye discloses that pets and boats can disappear after logging off unless precautions are used (e.g., have the boat be at anchor and have PCs of some sort walk by it every now and then).

There is no language in the cited passages that discloses that a set of transitions between members of the sequence of the second entities comprises an algorithm for the physical model problem solution. Thus, Drye does not disclose all of the limitations of claims 4, 11 and 18, and thus Drye does not anticipate claims 4, 11 and 18. M.P.E.P. §2131.

Applicants further assert that Drye does not disclose "wherein the said first set of physical entities comprises optimization constraints, and said first set of entities in a massively multiplayer online game comprises characters and equipment in said massively multiplayer online game" as recited in claim 7 and similarly in claims 14 and 21. As understood by Applicants, the Examiner cites pages 4, 22 and 27 of Drye as disclosing the above-cited claim limitations. Office Action (8/6/2007), pages 3-4. Applicants respectfully traverse.

As discussed above, Drye instead discloses that when you log off, if you want to protect your character, you should find an inn and walk into one of the rooms prior to logging off. Also, Drye discloses that pets and boats can disappear after logging off unless precautions are used (e.g., have the boat be at anchor and have PCs of some sort walk by it every now and then).

There is no language in the cited passages that discloses that the first set of physical entities comprises optimization constraints. Thus, Drye does not disclose all of the limitations of claims 7, 14 and 21, and thus Drye does not anticipate claims 7, 14 and 21. M.P.E.P. §2131.

As a result of the foregoing, Applicants respectfully assert that not each and every claim limitation was found within Drye, and thus claims 1-4, 7-11, 14-18 and 21 are not anticipated by Drye. M.P.E.P. §2131.

III. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 5-6, 12-13 and 19-20 under 35 U.S.C. §103(a) as being unpatentable over Drye in view of "Tutorial to New Players of Ultima Online v. 1.3" (hereinafter "Lindell") and "Something is Killing the Sims, and It's No Accident" (hereinafter "Markoff"). Applicants respectfully traverse these rejections for at least the reasons stated below, and respectfully request the Examiner to reconsider and withdraw these rejections.

A. Drye, Lindell and Markoff, taken singly or in combination, do not teach at least the following claim limitations.

Applicants respectfully assert that Drye, Lindell and Markoff, taken singly or in combination, do not teach "wherein said subset of members of the second set of physical entities defines a set of experimental protocols for testing against a subset of said first set of physical entities wherein said subset of said first set of physical entities comprises an inverse mapping of members of the second set of entities in the massively multiplayer online game having an outcome exceeding a preselected outcome" as recited in claim 5 and similarly in claims 12 and 19. As understood by Applicants, the Examiner cites page 17 of Drye, Section VIII of Lindell and paragraphs 3, 5, 9, 10 and 11 of Markoff as teaching the above-cited claim limitations. Office Action (8/6/2007), pages 4-5. Applicants respectfully traverse.

Drye instead teaches that a cure can be used if you are poisoned by an opponent (e.g., a snake, a giant scorpion, a human using a poisoned weapon). Page 17.

Lindell instead teaches that poison takes your hit points away, and even stamina, so heal it fast. Section VIII. Lindell further teaches that deadlier poisons do it more faster than weaker poisons of course. Section VIII. Lindell additionally teaches that you can heal poison by drinking a cure portion (the orange one), casting a cure spell or by using healing. Section VIII. Hence, Lindell teaches that a character

subject to poison may lost some hit points. Further, Lindell teaches that the character can be healed by drinking a cure portion or casting a cure spell.

Markoff instead teaches that Sims players discovered that the pet guinea pig was carrying a potentially fatal virus that could kill a human character in the game. Paragraph 5. Markoff further teaches that like almost everything in the game, the guinea pig's function as a disease vector was carefully simulated. Paragraph 10. Markoff additionally teaches that the guinea pig only spreads the disease if a Sims player neglects to clean its cage, and only if a player reaches into the cage to pet the software animal and is bitten will he get sick. Paragraph 10. Further, Markoff teaches that a sick character will return to health if given sufficient rest. Paragraph 11. Hence, Markoff teaches of a pet guinea pig in a game called "Sims" that spreads a disease to characters in the game if the character does not clean the cage and is bitten by the guinea pig. Markoff further teaches that the sick character will return to health if given sufficient rest.

There is no language in the cited passages that teaches that the subset of members of the second set of physical entities defines a set of experimental protocols. Neither is there any language in the cited passages that teaches that the subset of members of the second set of physical entities defines a set of experimental protocols for testing against a subset of the first set of physical entities. Neither is there any language in the cited passages that teaches that the subset of the first set of physical entities comprises an inverse mapping of members of the second set of entities in the massively multiplayer online game having an outcome exceeding a preselected outcome. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5, 12 and 19, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Drye, Lindell and Markoff, taken singly or in combination, do not teach "said first set of physical entities comprises pathogenic organisms; said first set of entities in a massively multiplayer online game comprises antagonists in said massively multiplayer online game; said second set of physical



entities comprises pharmaceutical agents; and said second set of entities in the massively multiplayer online game comprises characters and equipment in said massively multiplayer online game" as recited in claim 6 and similarly in claims 13 and 20. As understood by Applicants, the Examiner cites page 17 of Drye, Section VIII of Lindell and paragraphs 3, 5, 9, 10 and 11 of Markoff as teaching the above-cited claim limitations. Office Action (8/6/2007), pages 4-5. Applicants respectfully traverse.

As stated above, Drye instead teaches that a cure can be used if you are poisoned by an opponent (e.g., a snake, a giant scorpion, a human using a poisoned weapon). Page 17.

Lindell instead teaches that poison takes your hit points away, and even stamina, so heal it fast. Section VIII. Lindell further teaches that deadlier poisons do it more faster than weaker poisons of course. Section VIII. Lindell additionally teaches that you can heal poison by drinking a cure portion (the orange one), casting a cure spell or by using healing. Section VIII. Hence, Lindell teaches that a character subject to poison may lost some hit points. Further, Lindell teaches that the character can be healed by drinking a cure portion or casting a cure spell.

Markoff instead teaches that Sims players discovered that the pet guinea pig was carrying a potentially fatal virus that could kill a human character in the game. Paragraph 5. Markoff further teaches that like almost everything in the game, the guinea pig's function as a disease vector was carefully simulated. Paragraph 10. Markoff additionally teaches that the guinea pig only spreads the disease if a Sims player neglects to clean its cage, and only if a player reaches into the cage to pet the software animal and is bitten will he get sick. Paragraph 10. Further, Markoff teaches that a sick character will return to health if given sufficient rest. Paragraph 11. Hence, Markoff teaches of a pet guinea pig in a game called "Sims" that spreads a disease to characters in the game if the character does not clean the cage and is bitten by the guinea pig. Markoff further teaches that the sick character will return to health if given sufficient rest.

There is no language in the cited passages that teaches that first set of physical entities comprises pathogenic organisms. Neither is there any language in the cited passages that teaches that the first set of entities in a massively multiplayer online game comprises antagonists in the massively multiplayer online game (where the first set of physical entities is mapped to the first set of entities as required by claims 1, 8 and 15). Neither is there any language in the cited passages that teaches that the second set of physical entities comprises pharmaceutical agents. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 6, 13 and 20, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

B. Examiner's rationale for modifying Drye with Lindell to include the missing claim limitations of claims 5-6, 12-13 and 19-20 is insufficient to establish a *prima facie* case of obviousness.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

As understood by Applicants, the Examiner admits that Drye does not teach "wherein said subset of members of the second set of physical entities defines a set of experimental protocols for testing against a subset of said first set of physical entities wherein said subset of said first set of physical entities comprises an inverse mapping

of members of the second set of entities in the massively multiplayer online game having an outcome exceeding a preselected outcome" as recited in claim 5 and similarly in claims 12 and 19. Office Action (8/6/2007), pages 4-5. As further understood by Applicants, the Examiner admits that Drye does not teach "said second set of physical entities comprises pharmaceutical agents" as recited in claim 6 and similarly in claims 13 and 20. *Id.* As further understood by Applicants, the Examiner asserts that Lindell teaches these missing claim limitations. *Id.* Applicants kindly request the Examiner to clarify which limitations in claims 5-6, 12-13 and 19-20 are taught by Drye, if any, and which limitations are not taught by Drye pursuant to 37 C.F.R. §1.104(c)(2). Further, Applicants kindly request the Examiner to identify which other reference (e.g., Lindell, Markoff) teaches which of these missing claim limitations pursuant to 37 C.F.R. §1.104(c)(2). As further understood, the Examiner's reasoning for modifying Drye with Lindell to include the above-cited missing claim limitations is "to play the role of a doctor and cure a disease, virus, heal bones, etc." Office Action (8/6/2007), page 5. Applicants kindly request the Examiner to clarify the reasoning for modifying Drye with Lindell pursuant to 37 C.F.R. §1.104(c)(2). The Examiner's reasoning, as understood by Applicants, is insufficient to establish a *prima facie* case of obviousness in rejecting claims 5-6, 12-13 and 19-20.

The Examiner has not provided any rational underpinning as to how the Examiner derived his motivation for modifying Drye to include the above-cited missing claim limitations. The Examiner simply states "to play the role of a doctor and cure a disease, virus, heal bones, etc." as reasoning for modifying Drye to include the above-cited missing claim limitations. While the Examiner may consider many factors in finding a reason to combine, the Examiner still must explain how the Examiner derived the reasoning for modifying Drye to include the above-cited missing claim limitations. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007). Consequently, the Examiner's reasoning for modifying Drye to include the missing claim limitations of claims 5-6, 12-13 and 19-20 is insufficient to support a *prima facie* case of obviousness for rejecting claims 5-6, 12-13 and 19-20. *Id.*

Furthermore, the Examiner's rationale ("to play the role of a doctor and cure a disease, virus, heal bones, etc.") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Drye to include the above-cited missing claim limitations of claims 5-6, 12-13 and 19-20. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 5-6, 12-13 and 19-20. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Drye is a guide intended for the beginning player of Ultima Online. Page 1, 1<sup>st</sup> paragraph. The Examiner has not provided any reasons as to why one skilled in the art would modify Drye (which teaches a guide intended for the beginning player of Ultima Online) to: (1) have a subset of members of the second set of physical entities define a set of experimental protocols for testing against a subset of the first set of physical entities where the subset of the first set of physical entities comprises an inverse mapping of members of the second set of entities in the massively multiplayer online game having an outcome exceeding a preselected outcome; and (2) have the second set of physical entities comprise pharmaceutical agents (missing claim limitations). The Examiner's rationale ("to play the role of a doctor and cure a disease, virus, heal bones, etc.") does not provide such reasoning.

Why would the reason to modify Drye (whose purpose is to present a guide intended for the beginning player of Ultima Online) to have a subset of members of the second set of physical entities define a set of experimental protocols for testing against a subset of the first set of physical entities where the subset of the first set of physical entities comprises an inverse mapping of members of the second set of entities in the massively multiplayer online game having an outcome exceeding a preselected outcome (missing claim limitations) be to play the role of a doctor and cure a disease or virus or heal bones? Further, why would the reason to modify Drye (whose purpose is to present a guide intended for the beginning player of Ultima Online) to have the second set of physical entities comprise pharmaceutical agents (missing claim limitation) be to play the role of a doctor and cure a disease or virus or heal bones? Drye is not necessarily concerned with playing the role of a doctor and

curing a disease or virus or healing bones. The Examiner cannot completely ignore the teachings of Drye in concluding it would have been obvious to modify Drye to include the above-cited missing claim limitations of claims 5-6, 12-13 and 19-20.<sup>1</sup> Further, what is the rational connection between having a subset of members of the second set of physical entities define a set of experimental protocols for testing against a subset of the first set of physical entities where the subset of the first set of physical entities comprises an inverse mapping of members of the second set of entities in the massively multiplayer online game having an outcome exceeding a preselected outcome (missing claim limitations) and playing the role of a doctor and cure a disease or virus or heal bones (Examiner's reasoning)? Additionally, what is the rational connection between having the second set of physical entities comprise pharmaceutical agents (missing claim limitation) and playing the role of a doctor and cure a disease or virus or heal bones (Examiner's reasoning)?

Hence, the Examiner's reasoning does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Drye to include the missing claim limitations of claims 5-6, 12-13 and 19-20. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 5-6, 12-13 and 19-20. KSR

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<sup>1</sup> For example, suppose that the invention of a super soaker gun (essentially a plastic gun that shoots water) was never developed and an Applicant filed for a patent application on the super soaker gun. Applicant claims a plastic gun with a container of water that shoots water. The Examiner cites a primary reference that teaches a plastic gun that shoots darts and cites a secondary reference that teaches a plastic toy that contains a container of water. Since the primary reference does not teach a container filled with water, the Examiner cites the secondary reference as teaching this missing claim limitation. The secondary reference specifically states that the purpose of the container is to carry water. The Examiner then concludes that it would have been obvious to modify the primary reference with the secondary reference in order to carry water. The Examiner believes that he/she has established a *prima facie* case of obviousness since the Examiner has found a reason to have a container of water. However, the Examiner is completely ignoring the teaching of the primary reference. Why would one skilled in the art modify a plastic gun that shoots darts to have a container of water? This is the key question to answer. While having a container of water may be used to carry water, that is irrelevant as far as the purpose of the primary reference. Simply citing to a passage in the secondary reference that discusses the purpose of that secondary reference may not be sufficient evidence for an obviousness rejection. After all, surely there is a reason as to why the secondary reference teaches the missing claim limitation or else why would it include it? The Examiner must explain the connection between the teachings of the primary reference and rationale of the secondary reference for including the missing claim limitation. Otherwise, everything can be deemed obvious and virtually nothing can be patented.

*International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

- C. Examiner's rationale for modifying Drye with Markoff to include the missing claim limitations of claims 6, 13 and 20 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner must provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

As understood by Applicants, the Examiner admits that Drye does not teach "said first set of physical entities comprises pathogenic organisms" as recited in claim 6 and similarly in claims 13 and 20. Office Action (8/6/2007), pages 4-5. As further understood by Applicants, the Examiner asserts that Markoff teaches this missing claim limitation. *Id.* As further understood, the Examiner's reasoning for modifying Drye with Markoff to include the above-cited missing claim limitation is "to increase the interactivity and realism of the video game." Office Action (8/6/2007), page 5. As further understood by Applicants, the Examiner cites paragraph 3 of Markoff as support for the Examiner's reasoning. *Id.* The Examiner's reasoning, as understood by Applicants, is insufficient to establish a *prima facie* case of obviousness in rejecting claims 6, 13 and 20.

As stated above, the Examiner cites paragraph 3 of Markoff as support for the Examiner's reasoning for modifying Drye with Markoff to include the above-cited missing claim limitation of claims 6, 13 and 20. Markoff teaches that Mr. Wright decided to push the interactivity and realism of the game one step further by introducing a game object (e.g., guinea pig) that was a Trojan horse. Paragraph 3. There is no language in Markoff (and in particular paragraph 3) that makes any suggestion to have the first set of physical entities comprise pathogenic organisms (missing claim limitation) in order to enhance the interactivity and realism of the game. The Examiner has to provide some rational connection between the cited passage that is the source of the Examiner's reasoning and the missing claim limitation. The Examiner's source of reasoning (paragraph 3 of Markoff) does not provide reasons as to why one skilled in the art would modify Drye to include the above-cited missing claim limitation of claims 6, 13 and 20. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 6, 13 and 20. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

Furthermore, the Examiner's rationale ("to increase the interactivity and realism of the video game") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Drye to include the above-cited missing claim limitation of claims 6, 13 and 20. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 6, 13 and 20. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Drye is a guide intended for the beginning player of Ultima Online. Page 1, 1<sup>st</sup> paragraph. The Examiner has not provided any reasons as to why one skilled in the art would modify Drye (which teaches a guide intended for the beginning player of Ultima Online) to have the first set of physical entities comprise pathogenic organisms (missing claim limitation). The Examiner's rationale ("to increase the interactivity and realism of the video game") does not provide such reasoning.

Why would the reason to modify Drye (whose purpose is to present a guide intended for the beginning player of Ultima Online) to have the first set of physical entities comprise pathogenic organisms (missing claim limitation) be to increase the interactivity and realism of the video game? Drye is not necessarily concerned with increasing the interactivity and realism of the video game. The Examiner cannot completely ignore the teachings of Drye in concluding it would have been obvious to modify Drye to include the missing claim limitations of claims 6, 13 and 20. Further, what is the rational connection between having the first set of physical entities comprise pathogenic organisms (missing claim limitation) and increasing the interactivity and realism of the video game?

Hence, the Examiner's reasoning does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Drye to include the above-cited missing claim limitation of claims 6, 13 and 20. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 6, 13 and 20. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007); *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).



IV. CONCLUSION:

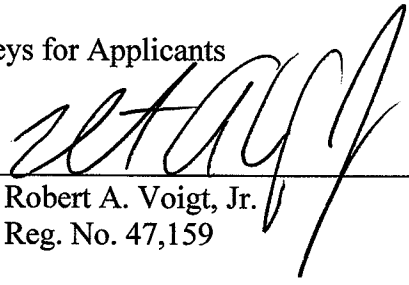
As a result of the foregoing, it is asserted by Applicants that claims 1-21 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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